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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,915	07/13/2006	Christopher Becker	100792-1P US	1090

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ASTRA ZENECA PHARMACEUTICALS LP
GLOBAL INTELLECTUAL PROPERTY
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WILMINGTON, DE 19850-5437

EXAMINER

JEAN-LOUIS, SAMIRA JM

ART UNIT	PAPER NUMBER
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1617

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06/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,915	Applicant(s) BECKER ET AL.	
	Examiner SAMIRA JEAN-LOUIS	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 10 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>Sheets (2)</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 1-5 and 7-14 are currently pending in the application.

Applicant's election of Group I (i.e. compound) and election of 4-(2-methylphenyl)-3a,4,5,9b-tetrahydro-3H-cyclopenta[c]quinoline-8-sulfonamide as the elected species in the reply filed on 03/14/08 is acknowledged. Additionally, the elected species appears to be free of the art, consequently the examination was extended to 4-(4-fluorophenyl)-3a,4,5,9b-tetrahydro-3H-cyclopenta[c]quinoline-8-sulfonamide. Examiner further acknowledges amendment to the claims including addition of new claims. However, because applicant elected group IV (i.e. compound), claim 14 (i.e. composition) will be withdrawn from examination.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Thus, the requirement is deemed proper and is therefore made FINAL.

Claims 1-5, 10, and 14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups and species, there being no allowable generic or linking claim.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d) for foreign priority based on an application filed in Sweden on 05/06/2003, which papers have been placed of record in the file.

IDS

The information disclosure statement filed on July 17, 2006 (specifically items WO 01/013330 A2) fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but only the information in the abstract referred to therein has been considered. Additionally, the information disclosure statement fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it includes search report citations. Applicant is advised that a search report is not a published document and therefore is not properly listed § 609.05(a).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (**see M.P.E.P 608.01 (k)**).

Claim 8 is particularly vague and indefinite given that applicant is claiming a compound of formula I or II where X is O, S, or CH₂ (**in sentence 5 of claim 8**). Given that applicant failed to indicate that X is O, S, or CH₂ only when the compounds are compounds of formula II, one of ordinary skill in the art would not be able to fully ascertain the metes and bounds of dependent claim 8 since independent claim 7 is directed to compounds of both formula I and formula II. However, applicant can overcome this rejection by amending the claim to read: A compound according to claim 7, wherein the compound is a compound of formula II, wherein: X is O, S, or CH₂, etc...

As a result of the above inconsistencies, the aforementioned claim is unable to be examined as disclosed given that the scope of the claimed subject matter would not be able to be determined by one of ordinary skill in the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 7, 9, and 11-13 are rejected under 35 U.S.C. 102(a) as being anticipated by AsInEx Express Gold Collection catalogue (AsInEx Express Gold Collection catalogue, citation XP-02291223, Publication date of April 2003, cited by applicant and filed on an IDS 1449).

AsInEx Express Gold Collection Catalogue teaches commercial availability of compound 4-(4-fluorophenyl)-3a,4,5,9b-tetrahydro-3H-cyclopenta[c]quinoline-8-sulfonamide before applicant's invention (see abstract). The aforementioned compound reads on the limitation of claims 7, 9, and 11-13 of formula I where the Aryl group is a phenyl substituted with the halogen fluorine and R1 is SO₂NH₂ (see abstract).

Accordingly, the teachings of AsInEx anticipate claims 7, 9, and 11-13.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samira Jean-Louis whose telephone number is 571-270-3503. The examiner can normally be reached on 7:30-6 PM EST M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. J. L./

Examiner, Art Unit 1617

06/05/2008

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617